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Serial No.: 10/723,977
Conf. No.: 9500

- 9 -

Art Unit: 3728

REMARKS

Applicants respectfully request reconsideration. Claims 1-30 and 34-36 were previously pending in this application. By this amendment, claims 1 and 35 have been amended. No claims have been added or canceled. As a result, claims 1-30, and 34-36 are pending for examination with claims 1, 8, 13, 23, 26, 34, and 35 being independent claims. No new matter has been added.

Allowable Subject Matter

Applicants gratefully acknowledge the Examiner's finding that claims 8-30, 34 and 36 are allowed and that claim 7 would be allowable if rewritten in independent form including all of the limitations of its base claim and any intervening claims. Claim 7 has not been rewritten into independent form, but depends on independent claim 1, which is believed to be allowable for the reasons discussed below.

Rejections Under 35 U.S.C. §102

In the Office Action dated March 13, 2006, claims 1, 2, 4-6 and 35 were rejected under 35 U.S.C. §102(b) as being anticipated by Graham (U.S. Patent No. 5,070,629). Applicants have amended independent claims 1 and 35 to more clearly distinguish over Graham.

Independent claim 1 has been amended to clarify that the claimed midsole insert is constructed and arranged to attach directly to an upper *without a stroble board* during a manufacturing step to secure the shape of the upper on a last where the insert is *devoid of an adjacent stroble board positioned between the plurality of energy return grid systems and a user*. Support for this amendment may be found at least one page 5, second paragraph, through page 6, last paragraph through page 7, third paragraph.

Graham is directed to a shoe construction having an energy return system. Graham states that the energy return system may include a net of monofilament fibers secured under tension positioned over an open area of the midsole. However, Graham does not teach or suggest a midsole insert that is constructed and arranged to attach directly to an upper *without a stroble board* during a manufacturing step to secure the shape of the upper on a last *where the insert is*

Serial No.: 10/723,977
Conf. No.: 9500

- 10 -

Art Unit: 3728

devoid of an adjacent stroble board positioned between the plurality of energy return grid systems and a user, as recited in amended claim 1.

Prior to the present application, according to a conventional method of shoe manufacturing, a stroble board is first attached to a shoe upper to secure the shape of the upper on a last. Once the shape of the upper is formed, the last is removed and other components of the shoe, such as, for example, a midsole and an outsole are attached. As discussed in the present application, a stroble board is typically made from a thin fiberboard material. Under this conventional approach, the stroble board separates the foot from a midsole component. As discussed in the present application, it may be desirable to not have a stroble board between the foot and the midsole component.

The Office Action states that Graham discloses means for stitching the midsole to an upper at 182 which is illustrated in FIGS. 19 and 20 in Graham. Reference numeral 182 is discussed in Graham in Column 10, lines 50-68, and specifically states that the midsole core 166 may be provided with upwardly extending flanges along the medial and lateral portions of the shoe as illustrated at 182 with the upwardly extending flange designed to be permanently secured to the upper of the shoe (not shown) by *conventional means*. As discussed above, conventional means included first using a stroble board to shape the upper. Graham states that the midsole core 166 may be secured to the upper by conventional means, but there is no teaching or suggestion in Graham for any midsole insert to be constructed and arranged to attached directly to the upper *without a stroble board during a manufacturing step, to secure the shape of the upper on a last*. Thus, claim 1 patentably distinguishes over Graham, such that the rejection under §102 should be withdrawn.

Claims 2 and 4-6 depend from claim 1 and all are thus patentable in view of Graham for at least the same reasons.

Independent claim 35 has been amended to clarify that the claimed midsole insert is constructed and arranged to attach directly to an upper *without a stroble board* during a manufacturing step to secure the shape of the upper on a last where the insert is *devoid of an adjacent stroble board*. Support for this amendment may be found at least one page 5, second paragraph, through page 6, last paragraph through page 7, third paragraph.

Serial No.: 10/723,977
Conf. No.: 9500

- 11 -

Art Unit: 3728

As discussed above, Graham does not teach or suggest any midsole insert constructed and arranged to attached directly to the upper *without a stroble board during a manufacturing step, to secure the shape of the upper on a last*. Thus, claim 35 patentably distinguishes over Graham, such that the rejection under §102 should be withdrawn.

Rejections Under 35 U.S.C. §103

In the Office Action, claim 3 was rejected under 35 U.S.C. §103(a) as being unpatentable over Graham.

Without acceding to the propriety of this rejection, claim 3 depends from independent claim 1 and are patentable for at least the same reasons set forth above. Accordingly, the rejection of this claim over Graham should be withdrawn.


CONCLUSION

A Notice of Allowance is respectfully requested. The Examiner is requested to call the undersigned at the telephone number listed below if this communication does not place the case in condition for allowance.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicants hereby request any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 23/2825.

Respectfully submitted,

By:


David Wolf, Reg. No. 17,528
Shannon Pratt, Reg. No. 55,548
Wolf, Greenfield & Sacks, P.C.
600 Atlantic Avenue
Boston, Massachusetts 02210-2206
Telephone: (617) 646-8000

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